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10/669,160

09/22/2003

Eduard K. de Jong

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EXAMINER

HOMAYOUNMEHR, FARID

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/669,160	Applicant(s) DE JONG, EDUARD K.	
	Examiner Farid Homayounmehr	Art Unit 2139	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/7/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/8/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: application, filed 9/22/2003; amendment filed 4/7/2008.
2. Claims 1-86 are pending in the case.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 4/8/2008 has been considered by the examiner. See attached form PTO-1449.

Response to Arguments

4.1. Double Patenting Rejection:

With regards to Double Patenting rejection, applicant argues that the '719 application (application number 10/243'355) has been abandoned, and therefore it cannot be used as grounds for Double Patenting rejection. The argument is found persuasive, however, a double patenting rejection based on another application is outlined in the next section.

4.2 Prior Art Rejections:

Applicant's argument relative to rejection of claims 1, 10, 19 and 28 under section 102(e) is moot in view of the new grounds of rejection outlined in the next section.

With regards to claims 2, 11, 20 and 30 applicant states that the rejection failed to consider the claim as a whole. However, applicant does not point out or discuss any part of the whole claim that is allegedly not been considered, or how the rejection fails to address all claim limitations as a whole.

Applicants also state that Muntz taught that such pools are unnecessary, but fails to identify any part of Muntz in support of their statement.

Applicant's argument relative claims 3, 4, 12, 13, 21, 22, 31, 32, 5, 14, 23, 29, is based on the dependency of the claims on claims 1, 2, 10, 11, 19, 20, 29, or 30.

With respect to claims 6 to 9, 15 to 18, 24 to 27, applicant simply states that the rejection is not related to the claims, or argues that the rejection does not consider the claim as whole, without specifically discussing why the rejection is unrelated, or which part of the whole claim is not considered.

With respect to claims 7 to 9, 15 to 18, 24 to 27, applicant argues again that the claim as a whole is not considered, without discussing any part of the whole claim that has not been considered.

With respect to Claim 33, 50, 67 and 84, applicant argues that there has been no teaching cited of delivery parameters as recited in these claims, a target ID, or the specific limitations recited in the claims. However, in addition to the associated rejections, pages 7-9 of the Final rejection explain how the rejection addresses all required limitations of the mentioned claims.

Applicant further argues that the specific limitations on how the target key and the first key are obtained are not disclosed. However, the specific limitations mentioned by the applicant are determining the target key based on a target ID identifying the target device, or applying a cryptographic process to a first key and the content request to get the session key. Therefore, the cited limitations refer to creating a session key based on a combination of other keys (parameters) using a cryptographic process. Examiner has taken the official notice that this process is well-known to the one skilled in art. In other words combination of several parameters associated with the elements of an authentication process, such as the identification of the target system or the received request, was broadly used and practiced before the time of invention. As an example, see section page 175 of the text book "Applied Cryptography" by B. Schneier, a copy of which was included with the Final Office Action. Therefore, barring any expressed

unexpected results from the particular selection of parameters or the process of combination, it would have been obvious to the one skilled in art to provide the session key as identified by limitations of claim 33.

With regards to claims 34-49, 51-66, 68 -83, 85 and 86, applicant once again argues that the rejection failed to consider the claim as a whole. However, applicant fails to discuss which part of the whole claim is not been considered, or how the rejection fails to address all claim limitations as a whole.

With regards to claim 41, applicant cites a portion of the claim and simply states that rejection relies on generalities to reject the specific claim limitations. However, the associated rejection explains how the prior art teaches all claimed limitations. Applicant does not discuss how the rejection fails to teach all claim limitations.

Based on the discussion above, applicant's argument is found non persuasive. The next section outlines the currently applicable rejections.

Double Patenting

5.1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. See, *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1/130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5.2. Claims 1-4, 10-13, 19-22, 28, and 30-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 3, and 43 of Application No. 10/243'858 (de Jong et al.), hereinafter called '858. Although the conflicting claims are not identical, they are not patentably distinct from each other because de Jong discloses:

de Jong claim 1: A system for digital content access control, comprising: a first user device configured to: receive an authenticated digital content request in response to sending a digital content request comprising a request for digital content wherein said

authenticated digital content request includes said request for digital content; and send said authenticated digital content request;

a content provisioner configured to send said authenticated digital content request to said first user device, wherein said content provisioner, following receipt of said digital content request, creates said authenticated digital content request when a user associated with said digital content request is authorized to access and use said digital content;

a content repository configured to send said digital content to a second user device, following receipt of said authenticated digital content request, when said authenticated digital content request is associated with said digital content; and a synchronizer, coupled to said content provisioner and to said content repository, configured to: determine a synchronization event for synchronization of information used by said content provisioner to create said authenticated digital content request with information used by said content repository to validate said authenticated digital content request; and send said synchronized information to at least one of said content provisioner and said content repository in response to said synchronization event.

de Jong claim 2: The system of claim 1 wherein said second user device and said first user device are a same user device.

de Jong claim 3: The system of claim 1 wherein said digital content request comprises a Universal Resource Locator (URL); and said authenticated digital content request comprises a tokenized URL.

de Jong claim 43: A system for digital content access control, comprising:
a token issuer configured to: receive a digital content request comprising a request for digital content; and issue a token from a token pool associated with said digital content when a user associated with said digital content request is authorized to access and use said digital content; a token acceptor configured to validate e said token based at least in part on whether said token is associated with said digital content; and
a synchronizer configured to: determine a synchronization event for synchronization of token pool information used by said token issuer and said token acceptor; and send said synchronized information to at least one of said token issuer and said token acceptor in response to said synchronization event.

Claims 1, 10, 19, and 28 of the instant application are obvious over claims 1 and 2 above, as they produce a method for digital content access control, comprising:
receiving by a content provisioner a digital content request from an end-user device, comprising a request for digital content (the second paragraph of '858 shows the content provisioner sends the authenticated content request to the first user (end-user). The first paragraph shows that the authenticated content request was received by the first user in response to a request sent by the first user. Therefore, the content

provisioner received a request for content from the first user); creating, by said content provisioner following said receiving, an authenticated digital content request if an end-user associated with said digital content request is authorized to access said digital content (858' claim 1, paragraph 2); determining, by said content provisioner following said receiving and in said creating, one or more delivery parameters, said one or more delivery parameters identifying a target device to receive said digital content, wherein one or more parameters is used to determine the target device ('858 claim 1 paragraph 3 shows that the content provisioner sends the content to a second user device following the receipt of the authenticated request. Therefore, the authenticated request identifies the second user. Note that per '858 claim 2 the second and the first users are the same. Also note that, as shown in paragraph 2, the authenticated request includes the request sent by the first user, and the first user was authenticated to make sure it is entitled to receive the content. Therefore, the request sent by the first user identifies the first user as the one entitled to receive the content. Note also that the first user sends the authenticated request to the repository. Therefore, it is based on the request that it is determined where the content should be sent. In addition, the content repository prepares an authenticated request for delivery of the content. It would have been obvious to include the target identity by the content provisioning device, as the purpose of the content provisioning device is to control the access to content. Identifying the target that should receive the content is the most essential function of access control); and sending, by said content provisioner to send end-user device, said authenticated

Art Unit: 2139

digital content request including said one or more delivery parameters ('858 claim 1, paragraphs 1 and 2).

Claims 2, 3, 11, 12, 20-21, 30-31 of the instant application are obvious over claims 1, 2, 3 and 43 above, as they produce limitations of claim 1 and wherein said digital content request comprises a Universal Resource Locator (URL); said authenticated digital content request comprises a tokenized URL; and said creating further comprises: determining a token pool associated with said digital content; determining a token in said token pool; and creating a tokenized URL based at least in part on said token.

Claims 4, 13, 22 and 32 of the instant application are obvious over claims 1, 2, 3 and 43 above, as they produce limitations of claim 1 and wherein said token is from a token pool associated with the location of digital content for which access is authorized.

5.3. This obviousness-type double patenting is a provisional rejection as the conflicting claims have been allowed but have not been patented at this time.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 2139

7. Claims 1, 10, 19 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. All claims are amended to include an end-user and an end-user device. The differences between an end-user and a user are not described or identified in the Specification. It is not clear how an end-user further limits the claims.

In addition, claims are amended to include "and in said creating". Applicant does not point out any portion of the Specification in support of this limitation, and it is not exactly clear how it further limits or changes the scope of the claims.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 10, 19 and 28 rejected under 35 U.S.C. 102(e) as being anticipated by Muntz et al. (US Patent Application Publication No. 2003/0208681, filed May 6, 2002).

9.1. As per claims 1, 10, 19 and 28 Muntz is directed to a method for digital content access control, comprising: receiving, by a content provisioner, a digital content request from an end-user device comprising a request for digital content (Fig. 5A and associated text, and in particular paragraph 39. Note that per parag. 13, client 105 may include computer or computer systems, and therefore client 105 is an end-user device); creating, by the content provisioner following said receiving, an authenticated digital content request (Fig. 3 and associated text describes creation of a block list and a token identifying the resource to be accessed, the operations that could be performed on the resource and the user credentials. Note that as shown in paragraph 39, the generation of token and block list happens after a request is received) if an end-user associated with said digital content request is authorized to access said digital content (for example, paragraph 31, which shows the authentication is made using user credentials, and the user is associated with the its client device); determining, by said content provisioner following said receiving and in creating (Muntz client 105 is the target device (which receives the data and credentials) and the Administrative Server 104 (part of which is the Metadata Server 214) is the Content Provisioner. Per paragraph 19, metadata server sends the block list and the validation mechanism to the client 105. As indicated in Fig. 1 and paragraphs 12-14, client 105 and the metadata server are connected via network. To communicate via network, the metadata server is required to

identify the client as recipient of data, otherwise a network connection to transmit data cannot be established. In addition, per paragraph 32, the client 105 and Metadata server authenticate each other. This explicitly shows that the Metadata server identifies the client 105), one or more delivery parameters, said one or more delivery parameters identifying a target device to receive said digital content (the block list and the token determine access parameters and credentials of the user and the client device. In addition, paragraph 28 shows that the Block server authenticates the client using the token (which is part of authenticated request). Therefore, the authenticated request must contain an identifier of the client device); wherein said one or more delivery parameters is used to determine said target device (as mentioned above, the content provisioner determines delivery parameters which identify the target. Therefore, the delivery parameters are used to identify the target. In addition, per paragraph 32, the token includes credentials, such as operation type(s) authorized for the client. The token is generated by the metadata server. If the token identifies the operations allowed by the client, it must also identify the client, and is used to identify the client. Note that per parag. 13, client 105 may include computer or computer systems); and sending, by said content provisioner to said end-user device, said authenticated digital content request including said one or more delivery parameters (paragraph 19, where the block list and validation mechanism is returned to the client).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-9, 11-18, 20-27 and 29-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muntz et al. (US Patent Application Publication No. 2003/0208681, filed May 6, 2002) in view of Official Notice.

11.1. As per claim 2, Muntz is directed to the method of claim 1 wherein said digital content request comprises a Universal Resource Locator (URL); said authenticated digital content request comprises a tokenized URL; and said creating further comprises: determining a token pool associated with said digital content; determining a token in said token pool; and creating a tokenized URL based at least in part on said token (Muntz teaches identification of the resource to be accessed using a token and a block list as identified in rejection of claim 1. Examiner takes the official notice that a common and widely practice mechanism to identify a resource and credentials needed to access the resource is using URLs and tokenized URLs. It would have been obvious to a person skilled in art to use a tokenized URL as a mechanism to implement Muntz block list and token).

11.2. As per claim 3, Muntz is directed to the method of claim 2 wherein said tokenized URL further comprises a cryptogram based at least in part on an identifier that

describes the location of said digital content (Muntz teaches creating an encryption of the token and the block list in paragraph 39. Note that the token and/or the block list include information that identifies the resource, and therefore once encrypted, creates a cryptogram based on characteristics of the resource).

11.3. As per claim 4, Muntz is directed to the method of claim 2 wherein said token is from a token pool associated with the location of digital content for which access is authorized (generation or selection of tokens from a token pool to identify and describe the resource to be accessed was well-known at the time of invention).

11.4. As per claim 5, Muntz is directed to the method of claim 1, further comprising synchronizing with said content repository if synchronization is enabled (paragraph 23 teaches synchronization with the resource storage during authorization process).

11.5. As per claim 6, Muntz is directed to the method of claim 1 wherein said one or more delivery parameters comprises a serial number uniquely identifying said target device (paragraph 23 shows the credentials of the user and the client device are part of the authorization combination).

11.6. As per claim 7, 8 and 9 Muntz is directed to the method of claim 1, which describes a method for access control to digital data and determining whether the client is authorized to access data. After the access authorization is determined, the next step

is secure delivery of digital content. Examiner takes the official notice that use of a token to specify and communicate the parameters associated with the content delivery encryption protocol, such as the cryptographic process and methods to derive keys for encryption and decryption was well-known at the time of invention.

11.7. Limitations of claims 11-32 are substantially the same as limitations of claims 1-9 above.

11.8. As per claim 33, Muntz is directed to a method for digital content access control, comprising: receiving, by a content repository, an authenticated digital content request including one or more delivery parameters (Fig. 3 item 216 and Fig. 5B and associated text shows reception of an authenticated digital content request by a block server), wherein said one or more delivery parameters is used to determine the target device (see claim 1) said authenticated digital content request based at least in part on a digital content request comprising a request for digital content (see response to claim 1); validating, by said content repository, said authenticated digital content request, said validating comprising indicating said authenticated digital content request is valid if said authenticated digital content request is validly associated with said digital content and if said authenticated digital content request authenticates said digital content request (paragraphs 27-29); determining, by said content repository, a session key if said authenticated digital content request is valid (paragraph 28), said determining comprising: determining a target key based at least in part on a target ID obtained using

said one or more delivery parameters, said target ID identifying a target device; and applying a cryptographic process to a first key based at least in part on at least part of said authenticated digital content request together with said target key to create said session key; encrypting said digital content using said session key; and sending said encrypted digital content (as mentioned in response to claim 1, creation of a session key to encrypt the digital content for secure delivery to a target device was well-known and commonly used at the time of invention).

11.9. As per claim 34, creation of the session key based on another master key and parameters identified in a token were well-known at the time of invention.

11.10. Limitations of claims 35-41 are substantially the same as limitations of claims 1-9 and 33-35 above.

11.11. As per claim 42-45 Muntz is directed to the method of claim 33 wherein said validating further comprises: receiving a token; indicating said token is invalid if said token is not associated with an partially redeemed or unredeemed offset within a token offset window, said token offset window comprising one or more offset entries identified by a base number and an offset from said base number, said one or more offset entries associated with a token in a token pool formed by applying a cryptographic process to the sum of said base number and said offset from said base number, together with a token chain key, said token pool associated with said digital content; and updating the

offset entry associated with said token and indicating said received token is valid if said token is associated with a partially redeemed offset or unredeemed offset within said token offset window (Muntz is directed to limitations of claim 33 as discussed above. The additional limitations are directed to a method of checking the validity of a token selected from a token pool, wherein the token pool is associated with a digital content for controlling user access. Examiner takes the official notice that this method was well known in the art at the time of invention, and it would have been obvious to the person skilled in art to use the method to control and limit user access to digital data).

11.12. Limitations of claims 46-86 are substantially the same as limitations of claims 1-45 above.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

Art Unit: 2139

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farid Homayounmehr whose telephone number is (571) 272-3739. The examiner can be normally reached on 9 hrs Mon-Fri, off Monday biweekly.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Farid Homayounmehr

7/17/2008

Application/Control Number: 10/669,160
Art Unit: 2139

Page 20

/Kristine Kincaid/

Supervisory Patent Examiner, Art Unit 2139